

REMARKS

At the outset, the Examiner is thanked for the thorough review and consideration of the pending application. The Office Action dated November 27, 2009 has been received and its contents carefully reviewed.

Claim 1 is hereby amended. Claims 7-18 are canceled without prejudice or disclaimer. No new matter has been added. Accordingly, claims 1-6 are currently pending. Reexamination and reconsideration of the pending claims are respectfully requested.

The Office Action rejects claims 1-3, 5-8 and 18 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,270,649 to Zeikus et al. (*Zeikus*). Claims 7, 8, and 18 are canceled, so the rejection of these claims is moot. Applicants respectfully traverse the rejection of claims 1-3 and 5-6.

As required in M.P.E.P. § 2131, in order to anticipate a claim under 35 U.S.C. § 102, “the reference must teach every element of the claim.” *Zeikus* fails to teach or suggest all the elements of claims 1-3 and 5-6, and thus cannot render these claims obvious.

Claim 1 recites, “forming a biofilm on at least part of the surface of said electrode ... simultaneously ... subjecting said electrode to a bias potential.” *Zeikus* fails to teach or suggest at least these elements of claim 1. In fact, *Zeikus* discloses that “the biocatalyst and neutral red are preferably immobilized on the cathode. In the case of whole cell biocatalysts, self-immobilization on a fine woven graphite felt electrode was found to take place ... One wishing to immobilize a biocatalyst in the practice of the present invention could do so placing the biocatalyst, neutral red, and pyridine nucleotide cofactor between an electrode and an outer membrane (e.g., a polymer membrane) such that the biocatalyst, cofactor, and neutral red are sandwiched between the electrode and membrane. Alternatively, biocatalyst, neutral red, and pyridine nucleotide cofactor could be embedded in a matrix polymer and coated onto the electrode.” *Zeikus*, column 8, lines 44-61, emphases added. *Zeikus* is silent with respect to “subjecting said electrode to a bias potential.” Accordingly, claim 1 is allowable over *Zeikus*. Claims 2, 3, 5, and 6 variously depend from claim 1, and are also allowable for at least the same reasons as claim 1. Applicants therefore respectfully request withdrawal of the rejection of claims 1-3, 5-8 and 18.

The Office Action rejects claim 4 under 35 U.S.C. §103(a) as being obvious over *Zeikus* in view of U.S. Patent No. 7,122,273 to Chaix (*Chaix*). Applicants respectfully traverse the rejection.

Claim 4 depends from claim 1, and incorporates all the elements of claim 1. As discussed, *Zeikus* fails to teach or suggest at least the above-recited elements of claim 1, namely, “forming a biofilm on at least part of the surface of said electrode ... simultaneously ... subjecting said electrode to a bias potential.”

Chaix is a PCT national stage application of PCT/FR02/00290, filed on Jan. 24, 2002. Because PCT/FR02/00290 was filed and published in French, *Chaix* does not have 102(e) date. *Chaix* was published on October 17, 2006, well after the U.S. filing date of present application, February 4, 2005. Therefore, *Chaix* does not constitute prior art against the present application. Nevertheless, *Chaix* still does not cure the deficiency of *Zeikus*. The Office Action only cites *Chaix* for disclosing that water is circulating water. *Chaix* is also silent with respect to the above-recited elements of claim 1.

Accordingly, claim 1 and its dependent claim 4 are allowable over the combined teaching of *Chaix* and *Zeikus*.

The Office Action rejects claims 9, 10, and 12 under 35 U.S.C. §103(a) as being obvious over *Zeikus* in view of U.S. Patent No. 6,379,828 to Worth et al. (*Worth*). The Office Action rejects claim 11 under 35 U.S.C. §103(a) as being obvious over *Zeikus* and *Worth* in view of *Chaix*. The Office Action rejects claims 13 and 14 under 35 U.S.C. §103(a) as being obvious over *Zeikus* and *Worth* in view of U.S. Patent Application Publication No. 2003/0162063 to Yoshizawa et al. (*Yoshizawa*). The Office Action rejects claim 15 under 35 U.S.C. §103(a) as being obvious over *Zeikus* in view of U.S. Patent Application Publication No. 2003/0087144 to Sun et al. (*Sun*). The Office Action rejects claim 16 under 35 U.S.C. §103(a) as being obvious over *Zeikus* in view of U.S. Patent No. 5,976,719 to Kim et al. (*Kim*). The Office Action rejects claim 17 under 35 U.S.C. §103(a) as being obvious over *Zeikus*.

Claims 9-17 are canceled, so these rejections are moot. Applicants respectfully request withdrawal of the rejections of claims 9-17.

The application is in condition for allowance and early, favorable action is respectfully solicited. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at (202) 496-7500 to discuss the steps necessary for placing the application in condition for allowance. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911.

Dated: March 26, 2010

Respectfully submitted,

By /Matthew T. Bailey/
Matthew T. Bailey
Registration No.: 33,829
McKENNA LONG & ALDRIDGE LLP
1900 K Street, N.W.
Washington, DC 20006
(202) 496-7500
Attorneys for Applicant